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09/747,117	12/22/2000	Laurence D. Hardesty	857-P-4	1034

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EXAMINER
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POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/747,117

Applicant(s)

HARDESTY ET AL.

Examiner

Frantzy Poinvil

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-10, 12, 13, 15-32, 35-39 and 44-47 rejected under 35 U.S.C. 102(e) as being anticipated by Burke (US Patent No. 6,112,191).

As per claim 1, Burke discloses a financial transaction system utilized by a plurality of participating consumers and benefit sponsors comprising:

- (a) establishing an investment account for the benefit of a participating consumer (see the abstract and column 12, line 66 to column 13, line 8 and column 14, lines 1-2) ;
- (b) administering the investment account in a manner that the investment account is entitled to accumulate income and gain on a tax deferred basis (column 14, lines 1-2, column 4, lines 11-28);
- (c) providing a plurality of benefit sponsors that offer goods and services to the participating consumer (figure 1E) ;

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(d) establishing an authorized payment method for the sale of said goods and services to the participating consumer (figure 2, column 2, line 61 to column 3, line 35 and column 5, line 42 to column 6, line 23);

(e) tracking the qualifying activity that results in the participating consumer being entitled to receive a deposit into or a disbursement from said investment account (column 4, lines 11-24);

and (f) providing a specified benefit to the participating consumer for utilizing the authorized payment method when purchasing goods and services, said benefit comprising a deposit into the participating consumer's investment account (column 4, lines 11-25 and lines 58-62 and the abstract).

As per claim 2, Burke discloses reporting on and accounting for the activities that result in the participating consumer being entitled to receive a deposit into, or disbursement from, said investment account (See column 4, lines 11-62).

As per claim 3, Burke discloses implementing a deposit into, or disbursement from, said investment account (see the abstract and column 4, lines 11-62).

As per claim 4, Burke discloses the participating consumer's investment account is established and administered in a manner that the investment account is entitled to accumulate income and gain on a non-tax deferred basis (see the abstract, column 4, lines 11-62, column 14, lines 1-2).

As per claim 6, Burke discloses the investment account is held and administered by a third party acting in a fiduciary capacity with respect to the investment account and the participating consumer. (Note column 4, lines 11-28).

As per claim 7, Burke discloses an individual may apply to become a participating consumer by providing specified information and wherein each resulting participating consumer is assigned an identification indicia unique to the system. (Note column 10, lines 28-45).

As per claim 8, Burke discloses qualifying activity of the participating consumer to the appropriate benefit sponsor. Note column 6, lines 37-45, column 5, lines 51-53.

As per claim 9, Burke discloses reporting the investment account activity of the participating consumer to the participating consumer. Note column 4, lines 11-29 and column 10, lines 55-65.

As per claim 10, Burke discloses reporting qualifying activity of the participating consumer to the participating consumer. Note column 5, lines 51-53 and column 10, lines 55-65.

As per claim 12, Burke discloses providing participating consumers with non-monetary incentives relating to goods and services offered by benefit sponsors. Note column 8, lines 45-67.

As per claim 13, Burke discloses providing participating consumers with promotions relating to goods and services offered by benefit sponsors. Note column 8, lines 45-67.

As per claim 15, Burke discloses an individual may obtain information and apply to become a participating consumer by applying via a global communications network. See figure 2 and column 10, lines 29-45.

As per claim 16, Burke discloses an entity may obtain information and apply to become a benefit sponsor by applying via a global communications network. Note figures 2 regarding a global communications network. Burke further teaches approved charities and organizations such as banks. See column 9, lines 50-62 and column 13, lines 1-8.

As per claim 17, Burke discloses a qualifying participating consumer may apply for and use a payment card as the authorized payment method, which payment card is issued by a benefit sponsor. Note column 10, lines 29-45 and column 11, lines 7-9.

As per claim 18, Burke discloses the participating consumer is entitled to receive a predetermined investment account benefit for all amounts spent using said payment card, independent of whether the merchant or service provider that accepts the payment card is also a benefit sponsor. Note column 10, line 55 to column 11, line 5.

As per claim 19, Burke discloses the account to which the funds are deposited are investment accounts that will make profit (or an incremental predetermined investment account benefit) to the participating consumer using the payment card to purchase goods and services from a benefit sponsor.

As per claim 20, Burke discloses the participating consumer is entitled to receive a predetermined investment account benefit for all amounts spent purchasing goods and services from certain designated benefit sponsors. The account to which the funds are deposited are investment accounts which will make profit (or a predetermined investment account benefit) to the participating consumer using the payment card to purchase goods and services from a benefit sponsor.

As per claim 21, Burke discloses a participating consumer may register and use a payment card as the authorized payment method, which payment card is not issued by a benefit sponsor. Note column 3, lines 48-63 and column 6, lines 62-64.

As per claim 22, Burke discloses the authorized payment method utilized by the participating consumer is selected from the group consisting of credit cards, on-line debit cards, off-line debit cards, travel and entertainment cards, smart cards, chip cards, stored value cards, cash, paper checks, electronic checks, truncated checks, an Internet wallet, electronic wallet or cyber-currency. Note column 6, lines 13-22 and column 17, lines 60-66.

As per claim 23, Burke teaches a participating consumer may apply for a payment card issued by a benefit sponsor by submitting the required information through a global communications web page operated by or on behalf of a benefit sponsor. Note column 10, lines 29-44.

As per claim 24, Burke discloses a participating consumer that also participates in an independent shopping or loyalty program may designate a predetermined portion of the benefits available to such participating consumer under the independent program be directed, as a deposit, into such participating consumer's investment account. Note column 11, lines 7-24, column 5, lines 37-41, column 12, line 66 to column 13, line 8 and column 14, lines 1-2.

As per claim 25, Burke discloses providing tracking, reporting and accounting for the investment account deposits resulting from a participating consumer's participation in said independent program. Note column 5, lines 51-53 and column 10, lines 55-64 of Burke.

As per claim 26, Burke discloses the benefit sponsor is a manufacturer of the predetermined good or service. Note column 3, lines 49-63 and column 4, lines 58-62.

As per claim 27, Burke discloses the benefit sponsor is a distributor of the predetermined good or service. Note column 3, lines 49-63 and column 4, lines 58-62.



As per claim 28, Burke discloses the system has access to transaction data such that the system can track and account for the participating consumer's purchase of the predetermined good or service. Note column 4, lines 11-49.

As per claim 29, Burke discloses the data is SKU data. Note column 6, lines 52-60.

As per claim 30, Burke discloses the data is Level II data. Note column 6, lines 52-60.

As per claim 31, Burke discloses the account to which the funds are deposited are investment accounts that will make profit (or an incremental predetermined investment account benefit) to the participating consumer using the payment card to purchase goods and services from a benefit sponsor.

As per claim 32, Burke discloses the participating consumer is entitled to receive an incremental investment account benefit by engaging in designated qualifying activity not requiring the purchase of goods or services. See column 8, lines 54-67 and column 6, lines 9-12.

As per claim 35, Burke discloses the benefit sponsors fund the participating consumer's investment account benefits via electronic transfer means. See figure 2.

As per claim 36, Burke discloses the electronic transfer means is the Automated Clearing House (ACH). Note column 3, line 65 to column 4, line 14.

As per claim 37, Burke discloses the electronic means comprises the Automated Clearing House. Note column 3, line 65 to column 4, line 14.

As per claim 38, Burke discloses the designated third parties, acting on behalf of and at the direction of benefit sponsors, fund the participating consumer's investment account benefits via electronic means. Note column 4, lines 11-62.

As per claim 39, Burke teaches elected information relating to the spending habits and preferences of participating consumers is accumulated and maintained in a secure electronic environment for use in connection with administering the system and for the exclusive benefit of the participating consumer and benefit sponsor. Note column 10, lines 55-59.

As per claim 44, Burke discloses each benefit sponsor may offer a customized account benefit to a participating consumer as a result of the participating consumer's purchase of certain goods or services or other qualifying activity. Note column 8, lines 45-53.

As per claim 45, Burke discloses a computer-based system operated for the benefit of a plurality of participating consumers and benefit sponsors (see the abstract) comprising:

(a) means for acquiring required data for each participating consumer (column 10, line 28 to column 11, line 6);

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(b) means for acquiring required data for each benefit sponsor (column 11, lines 6-7 and column 8, lines 33-67);

(c) means for acquiring the data required to track the qualifying activity of each participating consumer (column 13, lines 35-38, column 4, lines 11-63);

(d) means for storing the data described in (a) through (c) as all these data are stored;

(e) means for processing the data described in (a) through (c) such that investment account benefits are calculated (column 4, lines 11-63);

(f) means for reporting the results of (e) to participating consumers, benefit sponsors and investment account custodians (column 10, lines 55-60 and column 5, lines 51-53);

(g) means for responding to inquiries from participating consumers (column 10, lines 55-60 and column 5, lines 51-53);

(h) means for responding to inquiries from benefit sponsors (column 10, lines 55-60 and column 5, lines 51-53);

(i) means for acquiring the data necessary to, track, approve, and report on an addition to or a disbursement from an investment account (column 4, lines 11-63, column 10, lines 55-60 and column 5, lines 51-53);

(j) means for implementing an addition to or a disbursement from an investment account; and (k) means in (a) through (j) comprised of coded instructions that are executed by a group of computers (column 6, lines 9-44 and figures 1 and 2).

As per claim 46, Burke teaches the instruction comprises a plurality of machine readable instructions which, when executed by a discrete group of computers and related electronic

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devices, operating in tandem, causes such computers to perform each of the steps as set forth in (a) through (j). Note figures 1 to 2.

As per claim 47, Burke teaches . The system of claim 45 wherein a comprehensive and fully integrated computer and global communication system implements, operates and administers the system. See figures 1 to 2 and column 4, lines 11-29.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 11, 14, 33-34 and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke (US Patent No. 6,112, 191)..

As per claim 5, the participating consumer's investment account being pooled with like investment accounts of other participating consumers is not explicitly stated in Burke. The Examiner notes that these are known investment strategies that would have been obvious to one of ordinary skill in the art at the time of the invention to include such in the system of Burke in order to provide more funds into a type of investment.

As per claim 11, Burke discloses various types of sponsors in their system. Note column 3, lines 48-64 and column 5, lines 5-15 of Burke. Thus, these supermarkets, department stores or retail outlets usually provide direct advertising to the consumers. Therefore, providing the participating consumer with directed advertising relating to goods and services and other opportunities offered by benefit sponsors would have been obvious to the skilled artisan to do in the system of Burke in order to attract users to their system.

As per claim 14, Burke does not explicitly state providing customer service support to participating consumers by established communication systems. However, the Examiner asserts that customer support service is of prime importance to the success of a business. Providing customer service support in the system of Burke would have been obvious to one of ordinary skill in the art at the time of the invention in order to enable customer satisfaction and customer loyalty.

As per claim 33, the participating consumer may designate a third party as the beneficiary of the participating consumer's investment account is not explicitly stated in Burke. The Examiner notes that this step is well known in the insurance and investment practices as such would have been obvious to incorporate in the investment scheme of the investment providers of the system of Burke. The motivation would have been to provide investment practices just like a conventional investment firm.

As per claim 34, auditing and reconciliation processes are performed on most banking functions or operations as such would have been obvious to one of ordinary skill in the art to incorporate into the system of Burke so as to detect errors or fraud. It should be noted that an audit and reconciliation function which does not provide or permit an investment account benefit for goods and services that are returned or subject to payment dispute, including chargeback and retrieval processes is present in Burke as Burke does not mention such.

As per claims 40, 41 and 42, Burke teaches a participating consumer may use various communications devices. Applicant is directed to column 17, lines 60-66 where it is indicated well known medium for conducting electronically financial transactions. Including a pda, a cellular, digital or satellite and wireless communication device in the system of Burke for viewing or performing the financial transactions therein would have been obvious to one of ordinary skill in the art at the time of the invention in order to make the system versatile thus providing and facilitating the consumer with alternate communications means.

As per claim 43, Burke does not explicitly teach the statements are piggyback communications accompanying other communications. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have statements are piggyback communications accompanying other communications in order for both consumers and sponsors to maintain updates of reports and activities throughout the system.

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**Conclusion**

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

FP

December 11, 2003



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